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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,707	09/18/2003	Thomas Mayberry	EMPIR-060AUS	6021

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EXAMINER

DENG, ANNA CHEN

ART UNIT	PAPER NUMBER
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2191

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/665,707

Applicant(s)

MAYBERRY, THOMAS

Examiner

Anna Deng

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/26/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response the application filed on 9/18/2003.
2. Claims 1 – 10 are pending.
3. Claims 1 – 10 have been examined.

Specification

4. The use of the trademark JavaScript has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph because claims 1 and 6 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "better performance" in claims 1 and 6 (in line 4 and line 6 respectively) is a relative term which renders the claim indefinite. The term "better performance" is not defined by the claims, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.
7. Claims 4 and 9 are rejected under 37 U.S.C. 112 second paragraph because as containing the trademark/trade name JavaScript. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular

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material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe *** and, accordingly, the identification/description is indefinite.

8. Claim 4 and 9 recites the limitation "one of the group", "the user", "JavaScript" in claim 4, lines 15-16, and claim 9, lines 7-10, respectively. There is insufficient antecedent basis for this limitation in the claims.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claim 6 is set forth a computer program product comprising a computer usable medium having computer readable code. As recite in the Detailed Description Of The Invention, page 7, lines 20 – 26, "the invention may be embodied in a computer program product that includes a computer usable medium... such a computer usable medium can include a readable memory device... The computer readable medium can also include a communication link, either optical, wired, or wireless, having program code segments carried thereon as digital or analog signals (emphases added)". A claimed signal has on physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. 101. The office's current position is that claims involving signals encoded with functional descriptive material do not fall within any of the categories of patentable subject matter set forth in 35 U.S.C. 101, and such claims are therefore ineligible for patent protection. See 1300 OG 142 (November 22, 2005) (in particular, page 55 – 57, see Annex IV(c) 'Electro-Magnetic Signals').

Claims 6-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as being Electro-Magnetic Signals.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-3, 5-8, and 10 are rejected under 35 U.S.C. as being anticipated by Shiramizu, US 5,261,086 A (hereinafter Shiramizu).

Per Claim 1:

Shiramizu discloses:

- A method of providing improved performance for a software tool (col. 1, lines 30-35, and lines 51-57) comprising:
- accumulating data during execution of the tool (FIG. 1, System monitoring unit 15, col. 2, lines 52-56, col. 4, lines 16-22);
- examining the data (FIG. 1, knowledge input unit 16, col. 4, lines 23-37); and
- formulating recommendations on how to achieve better performance for the tool (col. 3, lines 8-31).

Per Claim 2:

Shiramizu discloses:

- The method of claim 1 further comprising applying the recommendations to the tool (FIG. 4, col. 3, lines 8-52).

Per Claim 3:

Shiramizu discloses:

- The method of claim 1 further comprising presenting the recommendations to a user of the tool (col. 5, lines 22-36).

Per Claim 5:

Shiramizu discloses:

- The method of claim 1 wherein said examining the data comprises applying a rule set to said data (FIG. 6, steps 63-66, col. 4, lines 38-68).

Per Claims 6-8, and 10:

These are the product version of the claimed method discussed above (claims 1-3, and 5), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by Shiramizu.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiramizu, US 5,261,086 A (hereinafter Shiramizu), in view of Lupo et al. US 6,973,625 B1 (hereinafter Lupo).

Per Claim 4:

Shiramizu teaches accumulating data during execution of the tool (Shiramizu, FIG. 1, System monitoring unit 15, col. 2, lines 52-56, col. 4, lines 16-22). Shiramizu does not explicitly teach accumulating at least one of the group consisting of events received from a browser, buttons the user pushed or clicked, internal errors that occurred, parsing the JavaScript of a page, and information about parameters for each request. However, Lupo teaches accumulating at least one of the group consisting of events received from a browser, buttons the user pushed or clicked, internal errors that occurred, parsing the JavaScript of a page, and information about parameters for each request (Lupo, col. 10, line 53-67, col. 14, lines 62-67, and col. 15, lines 1-14).

It would have been obvious to one having ordinary skill in the computer art at the time of the invention was made to modify the method disclosed by Shiramizu to include "accumulating at least one of the group consisting of events received from a browser, buttons the user pushed or clicked, internal errors that occurred, parsing the JavaScript of a page, and information about parameters for each request. However, Lupo teaches accumulating at least one of the group consisting of events received from a browser, buttons the user pushed or clicked, internal errors that occurred, parsing the JavaScript of a page, and information about parameters for each request" using the teaching of Lupo. The modification would be obvious because one of ordinary skill in the art would be motivated to provide a robust framework, which promotes greater code reuse and stability in the development of web-based user interfaces, by exploiting the advantages behind client-side scripting and Java subclassing (Lupo, col. 3, lines 42-46).

Per Claim 9:

This is the product version of the claimed method discussed above (claim 4), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also obvious.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna Deng whose telephone number is 571-272-5989. The examiner can normally be reached on Monday to Friday 9:30 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached at 571 -272-3708. The fax phone number for the organization where this application or proceeding is assigned is 703-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Anna Deng

October 10, 2006


Patent Examiner 2191